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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,917	03/10/2004	Kevin E. Dove	GK/56	7031

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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,917

Applicant(s)

DOVE, KEVIN E.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) 73-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 and 107-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0903, 1203</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-72, and 107-112, drawn to a gasket, classified in class 428, subclass 316.6.
- II. Claims 73-106, drawn to a method of forming a composite tape, classified in class 156, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, that the product as claimed can be made by another and materially different process such as one described at page 11, lines 20-31 of the WO 01/27501 invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Dianne Burkhard on 08/26/2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-72, and 107-112. Affirmation of this election must be made by applicant in replying to this Office action. Claims 73-106 are withdrawn from

further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

2. Claims 1-27 and 112 are objected to because of the following informalities: claim 1 preferably begins with "a" in accordance with US patent practice. Claim 112, line 1, the term "air" is repeated twice. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 recites the limitation "the adhesive" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5-10, 14-25, 28-34, 39-50, 53-55, 57-59, 61-70, and 107-112 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/27501 A1.

WO'501 discloses a gasket comprising at least two laminate tapes each comprising a plurality of porous expanded polytetrafluoroethylene (ePTFE) layers, the tapes comprising upper and lower laminate layers and side surface extending between upper and lower laminate layers, and one substantially air impermeable layer extending the length of the tapes and positioned between two tape side surfaces (figure 27, page 14, lines 25-26). The gasket is a form-in-place gasket (page 10, lines 16-17). The air impermeable layer comprises tetrafluoroethylene/perfluoroalkyl vinyl ether copolymer (PFA) or PTFE (page 15, lines 1-5). The air impermeable layer has a permeability to air less than the ePTFE (page 15, lines 17-32). Since the claims do not require the air impermeable layer and the reinforcing layer are the layers are separated from each other, the air impermeable layer 43 reads on Applicant's both impermeable layer and reinforcing layer. It appears that the ePTFE of WO'501 is prepared in a manner such as taught in US 3,953,566 as that of the present invention, therefore, it is not seen that the density, film orientation would be present outside the claimed ranges. Like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Accordingly, WO'501 anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-13, 36-38, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/27501 as applied to claims 1, 28, 53 above, and further in view of Gore (US 3,953,566). WO'501 does not specifically disclose the microporous expanded PTFE made from US 3,953,566 comprising carbon black, silica. Gore, however, teaches the microporous expanded PTFE comprising carbon black, silica. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use filler in the microporous expanded PTFE motivated by the desire to impart the strength of the microporous expanded PTFE material.
9. Claims 26, 27, 51, 52, 71, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/27501 as applied to claims 2, 53 above, and further in view of Hamilton et al (US 5,486,010). Hamilton discloses a gasket material comprising a pressure sensitive adhesive on at least one surface of the gasket to facilitate the sealing. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use adhesive on at least one of the upper and lower gasket surfaces motivated by the desire to facilitate the sealing.
10. Claims 4, 35, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/27501. Figure 27 does not show that the joint wherein the gasket

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when uncompressed has a substantially uniform thickness across upper and lower gasket surface. Figure 8 shows that the gasket when uncompressed has a substantially uniform thickness across upper and lower gasket surface.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the joint wherein each gasket when uncompressed has a substantially uniform thickness across upper and lower gasket surface as shown in figure 8 because such configuration is possible and acceptable for the gasket.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Haibo

**HAIVO
PRIMARY EXAMINER**